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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/600,237 | 06/19/2003 | Timothy Regan | 1026-090/MMM 303083.01 | 5539 |
| 27195 7590 07/25/2007 AMIN. TUROCY & CALVIN, LLP 24TH FLOOR, NATIONAL CITY CENTER 1900 EAST NINTH STREET CLEVELAND, OH 44114 | | | EXAMINER BAYARD, DJENANE M | |
| | | | ART UNIT 2141 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/600,237

Applicant(s)

REGAN, TIMOTHY

Examiner

Djenane M. Bayard

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No: _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to amendment filed on 5/08/07 in which claims 1-29 are pending.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive.

As per claim 21, Applicant argues that Thomas fails to teach providing for plural concurrent instant messaging user logins on a single multi-user computer. However, Thomas clearly teaches wherein a user is presented with the opportunity to join various chat groups and can join one or more chat groups (See col. 37, paragraph [0142] and col. 47, paragraph [0180]). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., multiple users can be logged into an instant messaging system simultaneously on a shared multi-user computer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As per claim 25, Applicant argues that Thomas is silent regarding the display of the instant message without a visible window surrounding the instant message. However, Thomas clearly teaches wherein the chat room region as an translucent overlay of television program. It would have been obvious to one with ordinary skill in the art that the instant message is displayed without a visible window since it is displayed as a translucent overlay of the television program (See paragraph [0157]).

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As per claim 28, Applicant argues that Thomas is silent regarding a user selectable portion of the video display. However, Thomas clearly teaches wherein any **suitable** arrangement may be used to display chat messages and television programming simultaneously (See paragraph [0156]).

As per claims 5, 14 and 26, Applicant's arguments have been fully considered but they are not persuasive. Thomas clearly teaches wherein the display can be opaque or translucent (See paragraph [0156]).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-29 are rejected under 35 U.S.C. 102(a) as being anticipated by European Patent Application No. EP 1 241 890 to Thomas.

a. As per claims 1 and 11, Thomas teaches a messaging system providing instant message communication between computers, a multi-user computer instant messaging method, comprising the steps of: providing plural concurrent instant message user logins on a multi-user computer (See paragraph [0143], paragraph [0142] and paragraph [0180]), one of the plural

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concurrent instant message user logins being a registered buddy of a user of a second computer (See page 29, paragraph [0200]); Furthermore, Thomas teaches providing to the second computer an indication that the registered buddy is one of plural concurrent instant message user logins on a multi-user computer (See paragraph [0200], *user only receives chat request from people on his buddy list*)

b. As per claims 2 and 20, Thomas teaches the claimed invention as described above.

Furthermore, Thomas teaches wherein one of the plural concurrent instant message user logins on the multi-user computer is a guest login that does not correspond to a specific instant messaging user (See page 21, paragraph [0145]).

c. As per claims 3 and 12, Thomas teaches the claimed invention as described above.

Furthermore, Thomas teaches wherein the multi-user computer renders a video display concurrently with the plural concurrent instant message user logins on the multi-user computer (See page 23, paragraph [0160]).

d. As per claim 21, Thomas teaches in an instant messaging system providing instant message communication between computers, multi-user computer instant messaging software in computer readable media, comprising: software for providing plural concurrent instant message user logins on a multi-user computer (See page 21, paragraph [0143] and page 36, paragraph [0142]) one of the plural concurrent instant message user logins being a registered buddy of a user of a second computer (See page 29, paragraph [0200]); and software for

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rendering on the multi-user computer a video display concurrently with the plural concurrent instant message user logins on the multi-user computer (See paragraph [0156]).

e. As per claim 22, Thomas teaches the claimed invention as described above. Furthermore, Thomas teaches rendering an instant message on the multi-user computer concurrently with the rendering of the video display (See page 23, paragraph [0160]).

f. As per claim 23, Thomas teaches the claimed invention as described above. Furthermore, Thomas teaches transmitting from the multi-user computer one of plural predefined instant messages (See page 17, paragraph [0120]).

g. As per claim 24, Thomas teaches the claimed invention as described above. Furthermore, Thomas teaches wherein predefined instant messages transmitted from the multi-user computer is selected by a user with a wireless remote control device (See page 19, paragraph [0130]).

h. As per claims 4, 13 and 25, Thomas teaches the claimed invention as described above. Furthermore, Thomas teaches rendering an instant message on the multi-user computer over a portion of the video display without a visible window surrounding the instant message (See page 22, paragraph [0156]).

i. As per claims 5, 14 and 26, Thomas teaches the claimed invention as described above. Furthermore, Thomas fails to teach wherein the instant message is rendered with a user-

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discernible fade in and a user-discernible fade out (See paragraph [0156], *opaque and translucent*)

j. As per claims 6, 15 and 27, Thomas teaches the claimed invention as described above. Furthermore, Thomas teaches wherein the instant message is rendered over a marginal region of the video display (See page 22, paragraph [0156]).

k. As per claims 7, 16 and 28, Thomas teaches the claimed invention as described above. Furthermore, Thomas teaches wherein the instant message is rendered over a user-selectable portion of the video display (See page 22, paragraph [0156]).

l. As per claims 8 and 17, Thomas teaches the claimed invention as described above. Furthermore, Thomas teaches wherein the multi-user computer renders a video display concurrently with the plural concurrent instant message user logins on the multi-user computer and the method further comprises rendering an instant message on the multi-user computer concurrently with the video display (See page 22, paragraph [0156]).

m. As per claims 9 and 18, Thomas teaches the claimed invention as described above. Furthermore, Thomas teaches transmitting from the multi-user computer one of plural predefined instant messages (See page 17, paragraph [0120]).

n. As per claims 10 and 19, Thomas teaches the claimed invention as described above.

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Furthermore, Thomas teaches receiving from a wireless remote control device a user indication of the one of plural predefined instant messages transmitted from the multi-user computer (See page 19, paragraph [0130]).

o. As per claim 29, Thomas teaches the claimed invention as described above. Furthermore, Thomas teaches providing one of the plural concurrent instant message user logins on the multi-user computer as a guest login that does not correspond to a specific instant messaging user (See page 2, paragraph [0145]).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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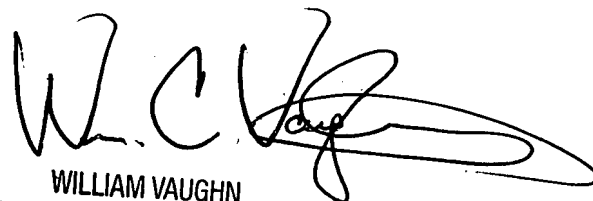
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M. Bayard whose telephone number is (571) 272-3878. The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Djenane Bayard

Patent Examiner



WILLIAM VAUGHN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100